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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,819	01/14/2002	Robert Arthur Glenn	0112753/004	4754

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EXAMINER	
MUROMOTO JR, ROBERT H	
ART UNIT	**PAPER NUMBER**
3765	

DATE MAILED: 06/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/047,819	GLENN ET AL.	
	Examiner	Art Unit	
	Robert H Muromoto, Jr.	3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,9-19 and 21-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7,9-19 and 21-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The disclosure is objected to because of the following informalities: The specification and claims recite that no elastomeric yarns are used in the instant invention. However, the specification goes on to state that a preferred yarn is a LYCRA® covered yarn. LYCRA® covered yarns are elastomeric yarns. This recitation renders the specification unclear.

"The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import; and in mechanical cases, it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein to which the term applies. ***A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term***. Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted. New claims and amendments to the claims already in the application should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the

application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification, (Ex parte Kotler, 1901 C.D. 62, 95 O.G. 2684 (Comm'r Pat. 1901). See 37 CFR 1.75, MPEP § 608.01(i) and § 1302.01)." Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The instant invention in independent claims 1, 21, and 23 requires a negative limitation that no elastomeric yarns be present in the invention. But the specification clearly uses an elastomeric yarn (GRILON®/LYCRA®; pg. 5, line 20) in making and using the invention. It would not be apparent to one skilled in the art at the time of invention how to make and/or use the instant invention from the disclosure of the instant invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The negative limitation reciting that no elastomeric yarns are used in the instant invention is unclear because the only yarn recited in the specification of the instant invention is an elastomeric yarn (GRILON®/LYCRA®).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-13 and 17-19, 21-26, are rejected under 35 U.S.C. 102(b) as being anticipated by GB 2309038 ('038 patent).

The '038 patent, discloses a tubular fabric formed from support yarns, fusible yarns and elastomeric yarns. After processing and cooling the melted (fusible yarns) yarn sets to form a durable lining (barrier) which exhibits excellent resistance to penetration by underwires (claims 1, 21, 22). As for the negative limitation with respect to the elastomeric yarn, it is not clear whether the applicant is claiming an embodiment that does use elastomeric yarns or not. Claims and the specification contradict each other in stating that in claim 1 no elastomeric yarn is present, while the specification states the use of LYCRA® covered yarns which are known to be elastomeric.

Additionally, applicant states that GRILON® covered LYCRA® would be appropriate yarns from the instant invention. Meanwhile the '038 patent uses the identical yarns. Since applicant in this statement is admitting that elastomeric yarns may be present in the instant invention, the '038 patent clearly anticipates the instant claims.

As for claims 2, 4-7, 9-13, and 17-19, the limitations are found verbatim in the '038 patent in claims 2-9, and 11-18, respectively.

'038 patent also discloses a tubular fabric made from support yarns, and fusible yarns to be formed into a bra, basque or swimming costume which includes an underwire (claims 23-26).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the '038 patent in view of WO 94/28227 9 ('227 patent).

Although the '038 patent teaches essentially all of the limitations of the claimed invention, there is no teaching with respect to a heat and pressure treatment to provide certain stretch characteristics to the fabric.

However, the '227 patent does teach a method of treating a woven fabric with heat and pressure to a fabric in such a manner that the yarn strands substantially

across the fabric width are forced closer together thus imparting generally semi-permanent or permanent ease or stretch into the fabric.

Therefore it would have been obvious to treat the '038 fabric with heat and pressure to attain certain stretch characteristics.

With respect to the limitation of processing temperature, the specification contains no disclosure of either the critical nature of the claimed limitations nor any unexpected results arising therefrom, and that as such the limitations were arbitrary and therefore obvious. Such unsupported limitations cannot be a basis for patentability, since where patentability is said to be based upon particular dimensions or another variable in the claim, the applicant must show that the chosen variables are critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the ideal processing temperature for a particular application.

Response to Arguments

Applicant's arguments filed 3/8/2004 have been fully considered but they are not persuasive.

Applicant has not overcome first paragraph, 35 U.S.C. 112, rejections. The specification states that GRILON® covered LYCRA® would be appropriate yarns from the instant invention. The claims go on to state a negative limitation that no elastomeric yarns are used in the instant invention. One of ordinary skill in the art would not be enabled to make or use this invention. It is impossible to make a fabric, using no elastomeric yarns, when a stated suitable yarn is an elastomeric yarn.

Applicant has overcome previous 35 U.S.C. 112, 2nd paragraph rejections.

Applicant argues that since the '038 patent uses an elastomeric yarn that it does not anticipate the instant invention. The examiner disagrees. The instant specification states that GRILON® covered LYCRA® would be appropriate yarns from the instant invention. This is the same yarn used in the '038 patent. Regardless of what the yarn is called it is the same yarn as the yarn in the instant invention. The '038 patent clearly anticipates the claims listed in the previous rejection.

Applicant argues that the 103 rejection is improper because there is no motivation to impart stretch characteristics to stretch tubular fabrics and that the references cited are not in the same technical area since one reference teaches an inner fabric and one teaches an outer fabric. These arguments are not persuasive and have no merit. The motivation to impart certain stretch characteristics to a stretch tubular fabric is clear. A "stretch" fabric is just that a stretch fabric, to use a heating and tension process to impart certain stretch characteristics to a fabric is even more critical in a stretch material fabric to control the amount of elasticity for a predetermined application. As for the technical areas of problem solving, all references cited in these rejections are drawn to fabric manufacture and processing. There is no delineation in the art of fabric processing for so called "inner" and "outer" fabrics. The problems solved for the production of a fabric apply to any other fabric.

As such the previous rejection remains and is considered proper.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert H Muromoto, Jr. whose telephone number is 703-306-5503. The examiner can normally be reached on 8-530, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 703-305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Bhm
June 3, 2004

GARY L. WELCH
PRIMARY EXAMINER